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EXAMINER	
HUNTSINGER, PETER K	
ART UNIT	PAPER NUMBER
2624	

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/855,586	TOMINAGA, MASAHIKO	
	Examiner	Art Unit	
	Peter K. Huntsinger	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 May 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3,5,7-12 and 14-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 3, 5, 7-12, and 14-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The amendment filled on 12 May 2005 has been entered in full.

Response to Arguments

2. Applicant's arguments filed 12 May 2005 have been fully considered but they are not persuasive.

3. Applicant argues on page 13 of the response that:

The combination of Conte et al. and Minari do not disclose comparing a number N of the devices connected to the server that have been recognized by said recognizing means, and a number M of image forming devices already set as output destinations by said holding means, when the specified image forming device is set as an output destination by said setting means.

a. Conte et al. disclose comparing a number N of the devices (licenses of Fig. 4A, col. 6-7, lines 65-67, 1-3) connected to the server (server 114 of Fig. 1). Conte et al. further disclose that the licenses can correspond to machines operating according to license technology (col. 26, lines 38-44). Minari discloses a number of printers, i.e. a type of machine (printer 107 and 108 of Fig. 1, col. 2, lines 43-45), that have been recognized by said recognizing means (status obtaining program 604 of Fig. 6, col. 4, lines 50-51). Conte et al. disclose a

number M (assigned status, col. 6, lines 65-67) of image forming devices already set as output destinations by said holding means. Minari discloses the specified image forming device is set as an output destination by said setting means (print processing program of Fig. 6, col. 4, lines 40-57).

The combination of Conte et al. and Minari do not disclose in an event that said comparison means judges M to be less than N, setting of the specified image forming device as the output destination is permitted, and the number of image forming devices set as output destinations held by said holding means is updated, and, in an event that said comparison means judges N and M to be equal, setting of the specified image forming device as the output destination is not permitted.

b. Conte et al. disclose in an event that said comparison means judges M (assigned status, col. 6, lines 65-67) to be less than N (licenses of Fig. 4A, col. 6-7, lines 65-67, 1-3), setting of the specified image forming device as the output destination is permitted (306 of Fig. 3, col. 7, lines 20-23), and the number of image forming devices set as output destinations held by said holding means is updated (col. 7, lines 60-62). Conte et al. further disclose that the licenses can correspond to machines operating according to license technology (col. 26, lines 38-44). If the user request to use the machine is accepted, the license allowing the user to utilize the printer is provided, and the user can print using the printer. Conte et al. disclose in an event that said comparison means judges N (licenses

of Fig. 4A, col. 6-7, lines 65-67, 1-3) and M (assigned status, col. 6, lines 65-67) to be equal, setting of the specified image forming device as the output destination is not permitted (310 of Fig. 3, col. 7, lines 23-32). If the user request to use the machine is denied, the user is unable to print from the printer.

4. Applicant argues on page 14 of the response that:

The combination of Conte et al. and Minari do not disclose the server constantly or periodically recognizing the number of devices connected to the server using a recognizing means, and comparing a number n of recognized devices with a number m of image forming devices set as output destinations held in an output destination information holding means, and, in the event that n is judged to be less than m, a number of image forming devices for distributing and outputting jobs is restricted to at most the number n of recognized devices, or no jobs are output.

c. Official Notice was taken that periodically recognizing devices connected to a server is well known in the art. The reference Hattori et al. U.S. Patent 6,370,577 was added to demonstrate that periodically recognizing devices connected to a server is well known in the art (col. 15, lines 39-49). Conte et al., Minari, and Hattori et al. are combinable because they are all from the same field of network server systems. At the time of the invention, it would have been obvious to periodically recognize the connected printers. The motivation for periodically recognizing connected devices would have been allowing the user to

be informed of printers that are currently available to use. Conte et al. disclose comparing a number n (licenses of Fig. 4A, col. 6-7, lines 65-67, 1-3) with a number m (assigned status, col. 6, lines 65-67), and, in an event that n is judged to be less than m, a number of image forming devices for distributing and outputting jobs is restricted to at most the number n of recognized devices, or no programs are executed (310 of Fig. 3, col. 7, lines 23-32). Conte et al. further disclose that the licenses can correspond to machines operating according to license technology (col. 26, lines 38-44). Minari discloses a number of printers, i.e. a type of machine (printer 107 and 108 of Fig. 1, col. 2, lines 43-45). If the user request to use the machine is accepted, the license allowing the user to utilize the printer is provided, and the user can print using the printer. If the user request to use the machine is denied, the user is unable to print from the printer.

5. Applicant argues on page 16 of the response that:

The combination of Conte et al. and Minari do not disclose that in an event that the number of devices connected to said connecting means is less than a number of the plurality of image forming devices, said control means selects a number of image forming devices corresponding to a difference in these numbers, and forbids image data outputted from said image output means from going to the selected image forming devices.

d. Conte et al. disclose in an event that the number of devices connected to said connecting means (licenses of Fig. 4A, col. 6-7, lines 65-67, 1-3) is less than

a number a number of the plurality of image forming devices (assigned status, col. 6, lines 65-67), said control means (client computer 120a of Fig. 1, col. 1, lines 35-39) selects a number of image forming devices corresponding to a difference in these numbers, and forbids image data outputted from said image output means from going to the selected image forming devices (310 of Fig. 3, col. 7, lines 23-32). Conte et al. further disclose that the licenses can correspond to machines operating according to license technology (col. 26, lines 38-44). Minari discloses a number of printers, i.e. a type of machine (printer 107 and 108 of Fig. 1, col. 2, lines 43-45). If the user request to use a plurality of machines is denied, the user is forbidden from printing from those printers.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claim 19 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The computer program claimed is merely a set of instructions per se. Since the computer program is merely a set of instructions not embodied on a computer readable medium to realize the computer program functionality, the claimed subject matter is not statutory. See MPEP 2106 IV.B.1.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1, 5, 7-12, and 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minari U.S. Patent 6,809,831 and Conte et al. U.S. Patent 5,845,065.

Referring to claim 1, Minari discloses an image forming system including a server and client computers connected to a network, one or a plurality of image forming devices connected to either the network or the server, and devices of which one or a plurality can be connected to the server and which can be recognized by the server, said system comprising: input means for inputting to the server a job to be printed by an image forming device (col. 3, lines 2-4); rendering means for rendering the job input by said input means into an image (print job generator 204 of Fig. 2, col. 3, lines 25-26); output means for outputting an image rendered by said rendering means to an image forming device specified by the job (print job transmitter 205 of Fig. 2, col. 3, lines 26-30); setting means for setting the specified image forming device as an output destination at the server (Fig. 13, col. 7, lines 30-41); output destination information holding means for holding a number of image forming devices set as output destinations by said setting means (printer name display 301 of Fig. 3, col. 3, lines 41-43); recognizing means for recognizing a presence of devices connected to the server, and a number thereof connected (status obtaining program 604 of Fig. 6, col. 4, lines 50-51). Minari does not disclose expressly using a licensing system to restrict access to

printers. Conte et al. disclose comparison means (304 of Fig. 3, col. 6, lines 61-65) for comparing a number N (licenses of Fig. 4A, col. 6-7, lines 65-67, 1-3) and a number M (assigned status, col. 6, lines 65-67), and, in an event that said comparison means judges M to be less than N, setting of the specified image forming device as the output destination is permitted (306 of Fig. 3, col. 7, lines 20-23), and the number of image forming devices set as output destinations held by said holding means is updated, and, in an event that said comparison means judges N and M to be equal, setting of the specified image forming device as the output destination is not permitted (310 of Fig. 3, col. 7, lines 23-32). Conte et al. disclose utilizing the licensing system in controlling machines (col. 26, lines 38-44). Minari and Conte et al. are combinable because they are from the same field of computer software. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to implement the licensing system of Conte et al. with the printer of Minari. The motivation for doing so would have been to provide the benefits of licensing agreements to the use of printers and to ensure that the printing of protected material is track and accounted for. Therefore, it would have been obvious to combine Conte et al. with Minari to obtain the invention as specified in claim 1.

Referring to claim 5, Minari discloses an image processing device for outputting image data to a plurality of image forming devices, said image processing device comprising: input means for inputting an image forming job (col. 3, lines 2-4), wherein one of the plurality of image forming devices is specified as an output destination (Fig. 13, col. 7, lines 30-41); image processing means for generating image data for the

specified image forming device based on the image forming job (print job generator 204 of Fig. 2, col. 3, lines 25-26); image output means for outputting image data generated by said image processing means to the specified image forming device (print job transmitter 205 of Fig. 2, col. 3, lines 26-30); connecting means for connecting to one or a plurality of devices (network 109 of Fig. 4, col. 3, lines 64-66). Minari does not disclose expressly using a licensing system to restrict access to printers. Conte et al. disclose control means for restricting a number of programs, based on the number of programs (304 of Fig. 3, col. 6, lines 61-65), and, in an event that the number of programs is less than a number of the plurality of programs, said control means selects a number of programs corresponding to a difference in these numbers, and forbids executing from said programs (310 of Fig. 3, col. 7, lines 23-32). Minari and Conte et al. are combinable because they are from the same field of computer software. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to implement the licensing system of Conte et al. with the printer of Minari. The motivation for doing so would have been to provide the benefits of licensing agreements to the use of printers and to ensure that the printing of protected material is track and accounted for. Therefore, it would have been obvious to combine Conte et al. with Minari to obtain the invention as specified in claim 5.

Referring to claim 7, Conte et al. disclose an image processing device according to claim 5, wherein in an event that executing a program is forbidden, said control means notifies an originator of the execution to that effect (310 of Fig. 3, col. 7, lines 23-32).

Referring to claim 8 and 9, Official Notice is taken that it is well known in the art for a image forming job to include PDL data or data input from scanners. It would have been obvious for the printer of Minari to process PDL and scanner data because PDL simplifies the printer software and making photocopies requires a scanner and a printer and these are standard formats and sources for data being sent a printer for printing.

Referring to claim 10, Minari disclose an image processing device according to claim 5, further comprising obtaining means for obtaining data indicating a type of image forming device set for each device connected to said connecting means (print job attribute program 601 of Fig. 6, col. 4, lines 42-45), wherein said control means counts a number of devices per type of image forming device, and restricts by type of image forming device a number of image forming devices capable of producing an output for said image output means (step S1002-No of Fig. 10, col. 6, lines 31-36).

Referring to claim 11, Conte et al. disclose an image processing device according to claim 10, wherein, in an event that the specified program is a predetermined type, said control means does not restrict the number of programs capable of executing (col. 1, lines 51-54). Conte et al. teach a type of software that is unmonitored and is not restricted by control means and there are many things that can be printed out that are either in the public domain or are not protected.

Referring to claim 12, Minari discloses an image processing method for outputting image data to a plurality of image forming devices, said method comprising: an input step of inputting an image forming job (col. 3, lines 2-4), wherein one of the plurality of image forming devices is specified as an output destination (Fig. 13, col. 7,

lines 30-41); an image processing step of generating image data corresponding to the specified image forming device based on the image forming job (print job generator 204 of Fig. 2, col. 3, lines 25-26); an image output step of outputting image data generated in said image processing step to the specified image forming device (print job transmitter 205 of Fig. 2, col. 3, lines 26-30); an identifying step of identifying one or a plurality of devices connected to a predetermined interface (status obtaining program 604 of Fig. 6, col. 4, lines 50-51). Minari does not disclose expressly using a licensing system to restrict access to printers. Conte et al. disclose a control step of restricting a number of image forming devices capable of outputting in said image output step, of the plurality of image forming devices, based on a number of devices connected (310 of Fig. 3, col. 7, lines 23-32), and, in an event that the number of devices connected is less than a number of said plurality of image forming devices, said control step selects a number of image forming devices corresponding to a difference in those numbers from the plurality of image forming devices, and forbids image data outputted in said image output step from going to the selected image forming devices (310 of Fig. 3, col. 7, lines 23-32. Minari and Conte et al. are combinable because they are from the same field of computer software. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to implement the licensing system of Conte et al. with the printer of Minari. The motivation for doing so would have been to provide the benefits of licensing agreements to the use of printers and to ensure that the printing of protected material is track and accounted for. Therefore, it would have been obvious to combine Conte et al. with Minari to obtain the invention as specified in claim 12.

Referring to claim 13, Conte et al. disclose an image processing method according to claim 12, wherein, in an event that the number of devices connected is less than a number of said plurality of image forming devices, said control step selects a number of image forming devices corresponding to a difference in those numbers from the plurality of image forming devices, and forbids image data outputted in said image output step from going to the selected image forming devices (310 of Fig. 3, col. 7, lines 23-32).

Referring to claim 14, Conte et al. disclose an image processing method according to claim 12, wherein in an event that sending image data outputted in said image output step to the specified image forming device is forbidden, said control step notifies an originator of the image forming job to that effect (310 of Fig. 3, col. 7, lines 23-32).

Referring to claim 15 and 16, Official Notice is taken that it is well known in the art for a image forming job to include PDL data or data input from scanners. It would have been obvious for the printer of Minari to process PDL and scanner data because PDL simplifies the printer software and making photocopies requires a scanner and a printer and these are standard formats and sources for data being sent a printer for printing.

Referring to claim 17, Minari discloses an image processing method according to claim 12, further comprising an obtaining step for obtaining data indicating a type of image forming device set for each connected device identified in said identifying step (print job attribute program 601 of Fig. 6, col. 4, lines 42-45), wherein said control step

counts a number of devices per type of image forming device, and restricts by type of image forming device a number of image forming devices capable of producing an output in said image output step (step S1002-No of Fig. 10, col. 6, lines 31-36).

Referring to claim 18, Conte et al. disclose an image processing method according to claim 17, wherein, in an event that the specified image forming device is a predetermined type, said control step does not restrict the number of image forming devices capable of producing an output in said image output step (col. 1, lines 51-54). Conte et al. teach a type of software that is unmonitored and is not restricted by control means and there are many things that can be printed out that are either in the public domain or are not protected.

Referring to claim 19, Minari discloses a computer program executed by a computer of an image processing device for implementing a method of outputting image data to a plurality of image forming devices, said computer program comprising: code of an input step of inputting an image forming job wherein one of the plurality of image forming devices is specified as an output destination (S701 of Fig. 7, col. 5, lines 28-29); code of an image processing step of generating image data corresponding to the specified image forming device based on the image forming job (S702 of Fig. 7, col. 5, lines 29-30); code of an image output step of outputting image data generated in the image processing step to the specified image forming device (S703 of Fig. 7, col. 5, lines 30-32); code of an identifying step of identifying one or a plurality of devices connected to a predetermined interface (status obtaining program 604 of Fig. 6, col. 4, lines 50-51). Minari does not disclose expressly using a licensing system to restrict

access to printers. Conte et al. disclose code of a control step for restricting a number of image forming devices capable of receiving image data outputted in said image output step, of the plurality of image forming devices, based on a number of devices connected (310 of Fig. 3, col. 7, lines 23-32), and, in an event that the number of devices connected is less than a number of said plurality of image forming devices, said control step selects a number of image forming devices corresponding to a difference in those numbers from the plurality of image forming devices, and forbids image data outputted in said image output step from going to the selected image forming devices (310 of Fig. 3, col. 7, lines 23-32). Minari and Conte et al. are combinable because they are from the same field of computer software. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to implement the licensing system of Conte et al. with the printer of Minari. The motivation for doing so would have been to provide the benefits of licensing agreements to the use of printers and to ensure that the printing of protected material is track and accounted for. Therefore, it would have been obvious to combine Conte et al. with Minari to obtain the invention as specified in claim 19.

Referring to claim 20, Conte et al. disclose a computer-readable storage medium storing a computer program according to claim 19 (col. 35, lines 20-23).

3. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Minari U.S. Patent 6,809,831 Conte et al. U.S. Patent 5,845,065, and Hattori et al. U.S. Patent 6,370,577.

Referring to claim 3, Minari discloses an image forming system including a server and client computers connected to a network, one or a plurality of image forming devices connected to either the network or the server, and devices of which one or a plurality can be connected to the server and which can be recognized by the server, said system comprising: input means for inputting to said the server a job to be printed by an image forming device (col. 3, lines 2-4); rendering means for rendering the job inputted by said input means into an image (print job generator 204 of Fig. 2, col. 3, lines 25-26); output means for outputting an image rendered by said rendering means to an image forming device specified by the job (print job transmitter 205 of Fig. 2, col. 3, lines 26-30); setting means for setting the specified image forming device as an output destination at the server (Fig. 13, col. 7, lines 30-41); output destination information holding means for holding a number of image forming devices set as output destinations by said setting means (printer name display 301 of Fig. 3, col. 3, lines 41-43); and recognizing means for recognizing a presence of devices connected to the server and a number thereof connected (status obtaining program 604 of Fig. 6, col. 4, lines 50-51). Minari fails to teach a server constantly or periodically recognizing the number of devices connected to the server. Official Notice was taken that periodically recognizing devices connected to a server is well known in the art. The reference Hattori et al. U.S. Patent 6,370,577 was added to demonstrate that periodically recognizing devices connected to a server is well known in the art (col. 15, lines 39-49). Conte et al., Minari, and Hattori et al. are combinable because they are all from the same field of network server systems. At the time of the invention, it would have been obvious to periodically

recognize the connected printers. The motivation for periodically recognizing connected devices would have been allowing the user to be informed of printers that are currently available to use. Minari does not disclose expressly using a licensing system to restrict access to printers. Conte et al. disclose comparing a number n (licenses of Fig. 4A, col. 6-7, lines 65-67, 1-3) with a number m (assigned status, col. 6, lines 65-67), and, in an event that n is judged to be less than m, a number of programs is restricted to at most the number n, or no programs are executed (310 of Fig. 3, col. 7, lines 23-32). Minari and Conte et al. are combinable because they are from the same field of computer software. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to implement the licensing system of Conte et al. with the printer of Minari. The motivation for doing so would have been to provide the benefits of licensing agreements to the use of printers and to ensure that the printing of protected material is track and accounted for. Therefore, it would have been obvious to combine Conte et al. with Minari to obtain the invention as specified in claim 3.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PKH

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